

REMARKS

In the Office Action dated June 8, 2004, claims 1-17 were presented for examination. Claims 11-17 were objected to as being confusing. Claims 1-17 were rejected under 35 U.S.C. §112, second paragraph. Claims 1-10 were rejected under 35 U.S.C. §101. And, claims 1-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Zhang et al.*, U.S. Patent No. 6,119,160, in view of *Kilki et al.*, U.S. Patent No. 6,230,144.

The following remarks are provided in support of the pending claims and responsive to the Office Action of June 8, 2004 for the pending application.

In the Office Action of June 8, 2004, the Examiner assigned to the application objected to claims 11-17 as being confusing as to the focus of the claimed subject matter. Applicant has amended claims 11-13 to further clarify the statutory subject matter of the invention, specifically the "instructions" that provide the functionality of the invention. Accordingly, Applicants respectfully request that the Examiner remove this objection to the above noted claims.

In the Office Action of June 8, 2004, the Examiner assigned to the application rejected claims 1-17 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, the Examiner noted a concern with the language "at least one webserver function", "said function", and "at least one function accessed by the user" in claims 1, 6, and 11. Similarly, the Examiner noted concern with the language "summing amounts of usage" and "summing usage amounts" and how these may possibly be conflicting in claims 3, 8 and 13. Applicants have amended the claims to clarify the issues raised by the Examiner pertaining to claims 1, 6, and 11, and claims 3, 8, and 13. In addition, the Examiner has raised an issue with claim 3 and the determining step. Applicant has amended the claim to clarify that this claim further defines the determining step of claim 1, in which the term "determining" has been amended to "calculating" as this is a more accurate term. Finally, the Examiner has raised

an issue to the system claims, and whether or not the system is an apparatus or method. These claims have also been amended to clarify that they specifically pertain to the system as an apparatus in support of the invention. Accordingly, in view of the amendments to the claims, Applicants respectfully request that the Examiner remove the rejection under 35 U.S.C. §112, second paragraph.

The Examiner has rejected claims 1-10 under 35 U.S.C. §101 alleging that the claimed subject matter is directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims. Applicants have amended claims 1 and 6 to specify that these claims are directed to a computer implemented method/system. "To be statutory, a claimed compute-related processor must ... be limited to a practical application within the technological arts." MPEP §2106. Applicant's invention as noted in claims 1-10 calculates a usage amount that is utilized for billing a user for services provided. This is a concrete, tangible and useful result, not an abstract idea. Accordingly, Applicant respectfully requests that the Examiner remove the rejection of claim 1-10.

The Examiner has rejected claims 1-17 under 35 U.S.C. §103(a) as being unpatentable over *Zhang et al.* ('160) in view of *Kilkki et al.* ('144).

Applicants wish to note that in the Office Action dated June 8, 2004, the Examiner has returned to the same reasoning behind the grounds for the rejection of now claims 1-17 as asserted against earlier claims 1, 3-6, and 12-15 in the Office Action dated June 18, 2003. However, in the Examiner's Advisory Action dated September 10, 2003 in response to Applicants' arguments against the Examiner's original grounds for rejection, the Examiner did not dispute the Applicants' arguments that the prior art references did not provide any teaching, suggestion or motivation to combine the references. In fact, the Examiner states in the Advisory Action that "[a] motivation is not always required to be provided by a reference. An Examiner is considered a person of ordinary skill in the art." See Advisory Action, Continuation of Box 5, second paragraph, lines 3-4. In that response by the Examiner, the Examiner has conceded that the prior art by themselves does not provide a teaching, suggestion or motivation since the

Examiner found the need to provide the motivational aspect through themselves as opposed to any available prior art references. However, in conjunction with the RCE, Applicants responded to the Examiner's position and the specious nature of that position in view of established case law on that very point. See Response to Advisory Action dated January 26, 2004. Absent the support for the Examiner's assertion that they can provide their own motivation to combine the references, the Examiner now reverts back to their earlier conceded position from the Office Action dated June 18, 2003. Applicants contend that the Examiner is attempting to revive a rejected position vis-à-vis the lack of any teaching, suggestion or motivation to combine the prior art references contained within the references themselves. Accordingly, Applicants once again asserts that irrespective of whether or not the prior art references are analogous art, the prior art references do not teach, suggest, or motivate one of ordinary skill in the art to combine select elements of the references to create Applicants' claimed invention, as Applicant shall expand upon below.

Applicant hereby incorporates the comments pertaining to both *Zhang et al.* and *Kilkki et al.* in the Response to the Advisory Action dated January 26, 2004 and the Second Office Action dated August 18, 2003. Applicants' invention as shown in claims 1-17 functions on a different principle than that taught in *Zhang et al.* and *Kilkki et al.* Applicants' invention specifically includes assigning a weight score to a webserver function and accounting for the number of times the webserver function is accessed. When a webserver function is accessed, the access instance is entered into a user identified log. At the conclusion of webserver usage, a summation is conducted for accounting purposes based upon each webserver function accessed and the number of times that function was accessed. The summation determines the cost associated with the webserver function accesses.

Zhang et al. has neither any motivation or desirability to distribute payments among providers of a network, nor any motivation or desirability to account for access to a webserver function as both considerations are superfluous to *Zhang et al.* For it to be obvious to combine prior art references, the references must teach, suggest, or motivate one with ordinary skill in the art to combine the references and create the claimed invention. It is well accepted that

"[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. *Zhang et al.* teaches accounting for time duration and byte count for a specific server, while *Kilkki et al.* uses a weighted load based on an assigned priority value of a specific cell and the size of the cell, and uses these factors to account for payments to operators in a network. However, as *Zhang et al.* accounts for connection duration to a network and public and private domains in the network, *Zhang et al.* would gain nothing by incorporating the elements of either *Kilkki et al.* or Applicants' invention. Similarly, *Kilkki et al.* has no teaching or motivation to distribute payments among providers based upon webserver function. *Kilkki et al.* pertains to distribution of providers based upon cells in an ATM service architecture. Accordingly, neither *Kilkki et al.* nor *Zhang et al.* teaches, suggests, or motivates one of ordinary skill in the art into creating an accounting scheme based upon webserver functions and accesses to the functions, as claimed by Applicants.

The prior art must teach the desirability of the modification suggested by the Examiner. "The mere fact the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon et al.*, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). It is axiomatic that the subject matter of the claims may not be considered obvious as a result of a hypothetical combination of references unless something in the references suggests that an advantage may be derived from combining their teachings. *Id.* The Examiner has provided an appropriate explanation of why the prior art references are analogous to the pending application. However, *Zhang et al.* does not support a desirability or motivation for a weight score as taught by Applicants. Although *Kilkki et al.* discloses use of a weighted load for accounting, it is limited to use of distribution of payments among operators of a network in an ATM service architecture. It is not applied to billing a user for accessing a web-server function, as claimed by Applicant. None of the prior art references suggests the desirability of the modifications represented by Applicants' claimed invention. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece

together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Although *Zhang et al.* may be modified to incorporate a weight factor, there is no suggestion or motivation in the reference to do so. Accordingly, removal of the rejection of claims 1, 3-6, and 12-15 under 35 U.S.C. §103(a) as being obvious over *Zhang et al.* in view of *Kilkki et al.* is respectfully requested in view of the fact that there is no motivation for combining the references found within the references themselves.

Furthermore, it is important to note that Applicants’ method of combining the use of a webserver function with the quantity of times the function is accessed is not present in either prior art reference cited by the Examiner. In order for the claimed invention to be obvious under 35 U.S.C. §103(a), the prior art must teach or suggest all claimed limitations presented by the claimed invention. “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP §2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). As mentioned above, there is no teaching, suggestion or motivation in *Zhang et al.* to use a webserver function in combination with the number of times that function is accessed as a factor in an accounting protocol. Similarly, there is no teaching suggestion or motivation in *Kilkki et al.* to use a webserver function in combination with the number of times that function is accessed in computing the weighted load. Accordingly, the cited prior art, whether taken individually or in combination, fails to teach or suggest all the claim limitations present in Applicants’ claimed invention.

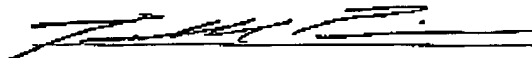
In view of the forgoing amendments and remarks, it is submitted that all of the claims remaining in the application are now in condition for allowance and such action is respectfully requested. Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that she be contacted at the number indicated below.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of

this application are respectfully requested.

Respectfully submitted,

By:



Rochelle Lieberman
Registration No. 39,276
Attorney for Applicant

Lieberman & Brandsdorfer, LLC
12221 McDonald Chapel Drive
Gaithersburg, MD 20878-2252
Phone: (301) 948-7775
Fax: (301) 948-7774
Email: rocky@legalplanner.com

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